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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/662,632 | 09/15/2003 | David Fu | 10448 | 9754 |
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| 36396 | 7590 | 09/07/2006 |
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| EXAMINER |
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HOGE, GARY CHAPMAN

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| ART UNIT | PAPER NUMBER |
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3611

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------|--|
| Office Action Summary | Application No. 10/662,632 | Applicant(s) FU, DAVID | |
| | Examiner Gary C. Hoge | Art Unit 3611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-24, 26-59, 61-67, 69, 70, 73, 74 and 76-85 is/are pending in the application.
 4a) Of the above claim(s) 7-11, 20-24, 26-37, 47, 48, 62 and 80 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-6, 13-19, 38-46, 49-59, 61, 63-67, 69, 70, 73, 74, 76-79 and 81-85 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2006 has been entered.

Election/Restrictions

2. Claims 7-11, 20-24, 26-37, 47, 48, 62 and 80 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 3, 2005.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 83 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim contradicts the claim from which it depends. It appears that claim 83 should have been made to depend from claim 81 rather than claim 82.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 13-18, 38-45, 49-58, 61, 63-67, 69, 70, 73, 74, 76-79 and 81-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neugebauer (5,522,163) in view of Wang (5,502,907).

Neugebauer discloses in Figs. 1-3 a protective display holder comprising a substantially rigid base **24** having a first edge and an opposite second edge, the base including a flat top surface **26** and a recess **48**, a substantially rigid cover **14** having a first edge and an opposite second edge, the cover including a flat bottom surface **18**, retaining means **20**, **32** adjacent to the first edge of the base and to the first edge of the cover for releasably retaining the bottom surface to the top surface, and a fastener **38** adjacent the second edges of the base and cover for securing the bases and cover together. However, Neugebauer uses a screw, rather than first and second magnetic members, to secure the cover to the base. Wang teaches that it was known in the art to use first **13** and second **23** magnetic members to secure a transparent cover to a base. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the screw disclosed by Neugebauer with magnets, as taught by Wang, in order to obviate the need for a screwdriver. Neugebauer shows in Figs. 1 and 3 that the cover includes a recess **46** that receives a protrusion/collar **36** formed on the base. The magnetic members taught by Wang would be embedded within the recess in the cover and in the protrusion/collar formed on the base.

Regarding claims 2, 40, 51 and 67, the cover and base are formed from transparent material.

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Regarding claims 3, 39, 50 and 63, the recess has depth and peripheral dimensions equal to or greater than a respective thickness and peripheral dimension of the flat item. See column 3, lines 37-39.

Regarding claim 6, Neugebauer shows in Figs. 1 and 3 that the base includes at least one aperture 32 and at least one projection 20 on the cover.

Regarding claims 13, 61 and 83, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the protrusion/collar on the cover and the recess within the base of Neugebauer because it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 166 (CCPA 1931).

Regarding claims 16, 18, 43, 45, 56, 58, 69, 70, 73, 74, 76 and 77, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the configuration of the collar and indentation in the shape of an oval (Neugebauer teaches the idea of making the collar and indentation in the shape of a circle) because it has been held that changes in the shape of an article are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed article is significant. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

7. Claims 19, 46 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neugebauer (5,522,163) in view of Wang (5,502,907) as applied to claims 1, 38 and 49 above, and further in view of Cameron (5,186,566).

Neugebauer, as modified, discloses the invention substantially as claimed, as set forth above. However, Neugebauer, as modified, does not disclose a finger notch along at least one of

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the second edges. Cameron teaches in Figs. 1-4, first and second panels that include finger notches **42** along the edges of each of the panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Neugebauer by placing a finger notch along at least one of the second edges, as taught by Cameron, because this would allow the cover and base to be separated in an easier manner.

Response to Amendment

8. The declaration under 37 CFR 1.132 filed June 26, 2006 is insufficient to overcome the rejection of the claims based upon Neugebauer and Wang as set forth in the last Office action because: There is no evidence that the commercial success was a direct result of the magnetic fastener rather than to some other factor, such as advertising, marketing, product placement, promotional give-aways, product availability, etc. Further, the declaration refers only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

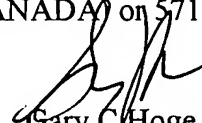
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gary C. Hoge
Primary Examiner
Art Unit 3611

gch